

Office Action Summary	Application No. 10/619,162	Applicant(s) HAYDEN ET AL.
	Examiner Harold Kim	Art Unit 2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 October 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 14 July 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

1. This action is responsive to applicant's amendment filed on 10/3/2005, which has been carefully studied by the Examiner. The arguments advanced therein are not persuasive and all of the rejections set forth in the previous Office action are hereby maintained.

2. Claims 1-16 are presented for examination.

3. Although Applicant agreed to file a terminal disclaimer upon receiving an indication of allowability, the nonstatutory double patenting rejection is maintained since Applicant has not been filed the terminal disclaimer.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b)

5. Claims 9-13 are rejected under the judicially created doctrine of double patenting over claims 1-5 of U. S. Patent No. 6,647,433 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Claim(s) 1-5 of patent # 6,647,433 contain(s) every element of claim(s) 9-13 of the instant application and as such anticipate(s) claim(s) 9-13 of the instant application.

Claims 1-8 and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,647,433. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakashita et al., US Patent no. 5,109,190.**

8. As to claims 1, 7-9, 12 and 13, Sakashita shows a method and a storage system comprising: issuing one or more commands to one or more inputs of a general purpose input/output (GPIO) system [col 1, lines 50-53], wherein the commands cause a first output of the GPIO system associated with a first input of the inputs to issue a control signal to a latch associated with a port bypass circuit (PBC) [col 1, lines 58-63; col 4, lines 1-30; col 9, lines 68 to col 10, line 9; fig 5], and a second output of the GPIO system associated with a second of the inputs of the GPIO system to issue a clock signal to a latch associated with a PBC addressed by the received commands [col 6, lines 26-49; fig 1]; and setting the state of the PBC with the received control signal if the control signal and the clock signal are consistent to change the state of the PBC [col 11, lines 1-10].

9. As to claims 2-6, 10, 11, and 14-16, Sakashita shows the system and method, wherein the control signal changes a state of the PBC [col 8, lines 16-21]; wherein the command is sent to a first GPIO device within the GPIO system to issue the first output, and to a second GPIO device within the GPIO system to issue the second output [col 10, lines 54-68]; the state of the PBC does not change unless the command is accurately received and a single latch associated with the PBC is addressed [col 8, lines 40-42]; wherein the command is a serial bus command addressing the PBC [col 4, lines 58-59]; wherein the command is an I2C command addressing PBC [col 5, lines 7-20]; constructing the one or more control commands in accordance with an error checking protocol [col 6, lines 10-12]; wherein the error checking protocol includes zero or more of calculating a cyclical redundancy check value for each command, or

encoding each command [col 5, lines 60-65; col 11, lines 17-24]; wherein setting the state of the PBC comprises forwarding, to the PBC, the control signal issued to the latch [fig 6A]; wherein the latch is to latch the control signal to the PBC only if the first input and the second input receive the command unchanged [figs 6B-6D].

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

In the remarks, applicants argued in substance that Sakashita et al. does not show a port bypass circuit (PBC).

Examiner respectfully traverses applicants' remarks.

Sakashita et al. clearly shows the port bypass circuit (PBC) [col 1, lines 58-63; col 4, lines 1-30; col 9, lines 68 to col 10, line 9; fig 5].

Conclusion

Applicant's arguments are not persuasive. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any response to this action should be mailed to:

Mail Stop _____
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The centralized fax number is 571-273-8300.

The centralized hand carry paper drop off location is:

U.S. Patent and Trademark Office
Customer Service Window, Mail Stop _____
Randolph Building
401 Dulany Street
Alexandria, VA 22314

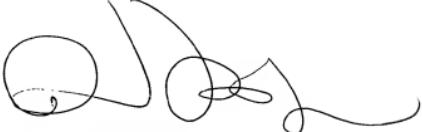
Any inquiry of a general nature or relating to the status of this application should be directed to the central telephone number (571) 272-2100.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harold Kim whose telephone number is 571-272-4148. The examiner can normally be reached on Monday-Thursday 6AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 571-272-4083. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HK
Harold J. Kim
Patent Examiner
December 11, 2005/HK



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